

REMARKS

Status of the Claims

Claims 1, 2, 4, 6-11, 13-17, 19, 21-26, 28-55, 59, 66, 68-74, and 77 are pending.

Claims 1, 2, 4, 6-11, 14-17, 19, 21-26, 29-55, 59, 66, 68-74, and 77 are rejected.

(Office Action, page 1.) Applicant acknowledges and appreciates the indication of allowable subject matter. Specifically, claims 13 and 28 are objected to as depending from rejected base claims, but the Office deems them allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. (*Id.*, page 4.)

Independent claims 1, 14, 59, 66, 68, 70, 72-74, and 77 were amended to more clearly recite the subject matter claimed therein, and dependent claims 4, 7, 8, 19, 22, and 23 were amended to be consistent with their respective independent claims. Support for these amendments can be found in the specification as filed, at least at pages 3-4, and in the original claims. Claim 6 was amended to introduce the word "is."

Accordingly, no new matter has been added by this amendment.

I. The Claims Are Enabled Under 35 U.S.C. § 112, First Paragraph

Claims 1, 2, 4, 6-11, 14-17, 19, 21-26, 29-55, 59, 66, 68-74, and 77 are rejected for lack of enablement under 35 U.S.C. § 112, first paragraph. (*Id.*, page 2.) The Examiner alleges that "[b]ecause the functional groups on the core structure of formula (1) are many and have different sizes, polarity, and electronegativity, the activity of compounds of formula (1) would be questionable." (*Id.*, page 2.)

As described in the Office Action, the “activity” of a compound appears to be related to “its ability to fit into the receptor site” and to the “binding interactions between the functionality of a drug (compound) and the functionality of the drug receptor site.” (*Id.*, page 2.) Applicant respectfully notes that such activity and binding interactions with a drug receptor site appear to be irrelevant to the present invention, in which the claimed compounds can be used in cosmetic and dermatological compositions. Clarification is requested with respect to this reference to activity, binding interactions, and receptor sites.

The Manual of Patent Examining Procedure states that “the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” M.P.E.P. § 2164.04. Applicant respectfully submits that the Examiner has failed to establish a reasonable basis to question the enablement of the claimed invention, particularly due to the seemingly irrelevant discussion of activity, binding interactions, and receptor sites. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

II. The Claims Are Not Indefinite Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 2, 4, 6-11, 14-17, 19, 21-26, 29-55, 59, 66, 68-74, and 77 are rejected as indefinite under 35 U.S.C. § 112, second paragraph. (*Id.*, page 2.)

In the Office Action, it is stated that:

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c).

Id., page 3

The Examiner alleges that these claims comprise a “broad recitation” (“R’ is chosen from linear and branched unsaturated hydrocarbons comprising 2 to 22 carbon atoms”) together with a “narrower statement” (“R’ is chosen from linear and branched hydrocarbons comprising C=C double bond”). (*Id.*, page 4.) Applicant respectfully traverses the Examiner’s rejection.

The definite scope of the rejected claims is clearly stated within the claims. For example, compounds of formula (I) include three Y substituents, each of which comprises an R’ substituent, resulting in a total of three R’ substituents per compound. Independent claims 1, 14, 59, 66, 68, 70, 72, and 73 recite that “at least one of said R’ groups is chosen from linear and branched, unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one C=C double bond” (emphasis added). As this provision is only a requirement for one of the three R’ groups, the remaining two R’ groups may be chosen from hydrogen atoms, optionally substituted aryl groups, and “linear, branched and cyclic, saturated and unsaturated hydrocarbons comprising 1 to 22 carbon atoms.” Therefore, claims 1, 2, 4, 6-11, 14-17, 19, 21-26, 29-55, 59, 66, and 68-73 do not “set forth a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation.” (*Id.*, page 3) Accordingly, Applicant respectfully requests withdrawal of the rejection.

Regarding the rejection of claims 74 and 77, Applicant respectfully submits that these claims do not recite the “narrower statement” that “R’ is chosen from linear and branched hydrocarbons comprising C=C double bond” (*Id.*, page 4). It appears that the

Office erroneously included these claims in the indefiniteness rejection. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 74 and 77.

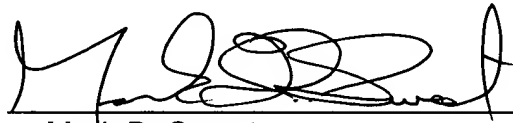
CONCLUSION

Applicant respectfully requests reconsideration of the application, and the timely allowance of the pending claims. Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Date: August 5, 2005

By: 
Mark D. Sweet
Reg. No. 41,469